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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. HIND and YONGCHENG LI

Appeal 2007-2299
Application 10/047,860
Technology Center 2100

Decided: January 8, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1, 2, 4-7, 9, 10, 13, 14, 16, and 17. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims relate to a system and method for database access using an edge-deployed database proxy driver. (Spec. 1.) The "edge" of a network refers to that portion of a publicly accessible network which is disposed communicatively closer to the end-user. (*Id.* 2.) Claim 1 is illustrative.

1. A database access system comprising:

a universal database connectivity driver having a first exposed interface through which access to a database server can be provided;

a database proxy driver registered with said universal database connectivity driver, said database proxy driver having a second exposed interface which conforms with said first exposed interface of said universal database connectivity driver, said database proxy driver having a configuration for invoking at least one auxiliary task in addition to providing access to said database server through said first exposed interface of said universal database connectivity driver; and,

a database driven application programmatically linked to said database proxy driver.

The Examiner relies on the following evidence to show unpatentability:

McHenry et al. (McHenry) US 2003/01115281 A1 Jun. 19, 2003
(filed Aug. 6, 2002)

U.S. Provisional Application No. 60/340,332, filed Dec. 13, 2001.

Claims 1, 2, 4-7, 9, 10, 13, 14, 16, and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McHenry.

Claims 3, 8, 11, 12, 15, 18, and 19 are objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form. (Ans. 5.)

An earlier rejection of claims 6 and 13 under 35 U.S.C. § 101 has been withdrawn by the Examiner. (Ans. 6.)

OPINION

According to this record, Applicants filed the instant application in the USPTO on January 15, 2002. The Examiner's rejection over the prior art relies on McHenry, a U.S. utility patent application filed August 6, 2002 and published June 19, 2003. A U.S. application, published under 35 U.S.C. § 122(b), may qualify as a reference under 35 U.S.C. § 102(e)(1) if the invention described therein was "by another" and "filed in the United States before the invention by the applicant for patent . . . ." *See* 35 U.S.C. § 102(e)(1). In this case, however, the date of "invention by the applicant for patent" is no later than January 15, 2002, which predates the filing date of McHenry.

The Examiner's rejection refers to a U.S. provisional application associated with McHenry. McHenry claims the benefit of U.S. Provisional Application No. 60/340,332, filed December 13, 2001. The provisional application filing date is earlier than the instant application filing date.

The Examiner's rejection does not set forth any basis under which McHenry or its related provisional application may be considered § 102(e)

prior art. We note, however, that the *Manual of Patent Examining Procedure* (MPEP) § 706.02(f)(1) (8th ed., Rev. 6, Sep. 2007), "Example 2," gives effect to U.S. provisional applications provided that certain conditions are met. According to Example 2, a published U.S. nonprovisional application that claims "benefit" under 35 U.S.C. § 119(e) to a prior U.S. provisional application is to be accorded the earlier filing date as its prior art date "under 35 U.S.C. § 102(e)," assuming the earlier-filed application "has proper support for the subject matter as required by 35 U.S.C. 119(e). . . ."

"[T]he subject matter" must refer to whatever subject matter in a published application that is relied upon in a rejection over the prior art. "[B]enefit" under § 119 requires, *inter alia*, an invention disclosed in the provisional application "in the manner provided by the first paragraph of section 112" (35 U.S.C. § 119(e)(1)), so "proper support" must refer to at least written description support as required by 35 U.S.C. § 112, first paragraph.

We will therefore assume for the purposes of this appeal that U.S. provisional applications can contribute to the effective filing date of a published application. Moreover, Appellants appear not to contend otherwise.

Appellants do, however, contend that the Examiner relies on material in McHenry that does not appear in the provisional application. Appellants submit, for example, that the rejection of independent claim 1 relies on paragraph [0040] of McHenry, which describes Figure 4 of the published application, but that Figure 4 does not exist in the provisional application.

The Examiner's response is that "[t]he text support for Figure 4 can still be found in Provisional Application 60/340,332 paragraph Figure 4 [sic] was used to depict use of a proxy to provide a generic application communication/access by connectivity to a database." (Ans. 6.) Appellants in the Reply Brief point out that the response neglects to identify the supposed "text support" for Figure 4 in the provisional application. We agree with Appellants' assessment.

The rejection of independent claims 6 and 13 relies on paragraphs [0013], [0030], and [0032] of McHenry. (Ans. 5.) In response to Appellants' argument that support for the material relied upon in the rejection has not been pointed out in the provisional, the Examiner submits that the subject matter of the paragraphs "can be found" in corresponding paragraphs of the provisional. (Ans. 6-7.) The Answer also relies on further portions of McHenry (*id.* 8), without any attempt to show where the material may find support in the provisional.

We agree with Appellants, as submitted in the Reply Brief, that the rejection fails to show proper support in the provisional for the material in McHenry applied against claim 1, as well as the material applied against the other independent claims (6 and 13). For example, paragraph [0028] of the provisional is alleged to correspond to paragraph [0030] of McHenry. (Ans. 6.) Paragraph [0030] of McHenry, however, describes the functions and operations of several components (e.g., content director 30, network edge servers 22, 24, content stores 14_{1-N}). Paragraph [0028] of the provisional does not describe any particular embodied components. The Answer (at 6)

submits that paragraph [0028] is "an over all description" of McHenry's Figure 1, showing request/transfer connectivity between "interfaced application and database, referenced to teach 'request from database application through an interface.'"

We note, however, that material at paragraph [0030] was submitted to be part of the description of both "receiving a database connectivity request through a corresponding first exposed database connectivity method from a database driven application" and "performing at least one auxiliary task in addition to forwarding said database connectivity request" (*see* Ans. 5) -- more than a mere "request from database application through an interface." Moreover, the alleged "performing at least one auxiliary task in addition to forwarding said database connectivity request" relies on text only in McHenry (¶¶ [0030], [0032]), rather than anything that may be taught by the drawings of McHenry (or the drawings of the provisional).

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The McHenry published application, by itself, shows no more than that which was filed in the USPTO on August 6, 2002, which is later than the instant application's filing date. Because we agree with Appellants that the rejection of at least the independent claims fails to show any kind of

§ 112 support in the McHenry provisional for all the material relied upon in the McHenry published application, we do not sustain the rejection of the claims under 35 U.S.C. § 102(e) over McHenry.

CONCLUSION

The rejection of claims 1, 2, 4-7, 9, 10, 13, 14, 16, and 17 under 35 U.S.C. § 102(e) as being anticipated by McHenry is reversed.

REVERSED

clj

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